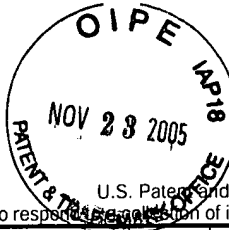


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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
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		10/664,259	September 17, 2003
		First Named Inventor	
		Thomas L. Byers	
Art Unit		Examiner	
3643		A. Valenti	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p>			
<p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 39,297 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p>		<p><u>Randall K. McCarthy</u> Signature</p> <p><u>Randall K. McCarthy</u> Typed or printed name</p> <p><u>(405) 232-0621</u> Telephone number</p> <p><u>11/23/05</u> Date</p>	
<p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT
DKT. OKC00085

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **Thomas L. Byers**
Application No.: **10/664,259**
Filed: **October 25, 2002**
For: **MODULAR ANIMAL ENCLOSURE**

Group Art Unit: **3643**
Examiner: **A. Valenti**

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**ACCOMPANYING ARGUMENTS FOR PRE-APPEAL
BRIEF REQUEST FOR REVIEW**

Sir:

This paper constitutes accompanying arguments for a pre-appeal brief request for review for the above identified U.S. patent application. A Notice of Appeal and a Pre-Appeal Brief Request for Review have been filed herewith.

Present Status of Claims

Claims 1-9, 11-13, 15-23, and 25-33 are pending. Claims 22, 23 and 31-33 are allowed. Claims 18, 19, 21 and 25 stand finally rejected under 35 U.S.C. §102(b), and Claims 1-9, 11-13, 15-17, 20 and 26-30 stand finally rejected under 35 U.S.C. §103(a).

The Applicant respectfully submits that these rejections are clearly erroneous, and the examination is incomplete pursuant to 37 CFR §1.104(a).

Claim Language at Issue for Anticipation Rejection

With regard to the anticipation rejection, independent claim 18 is a combination claim that generally features "*first means supported by a top surface of the housing for facilitating said flow of atmospheric air through the climate conditioning aperture.*"

Independent claim 25 is a combination claim that substantially features this "first means" element, as well as a "second means" element.

Deficiencies of Anticipation Rejection

The Applicant respectfully notes the following deficiencies with regard to the anticipation rejection of claims 18-19, 21 and 25:

1. THE EXAMINER'S POSITION IS NOT CLEAR ON WHETHER INDEPENDENT CLAIMS 18 AND 25 ARE WRITTEN IN ACCORDANCE WITH 35 U.S.C. §112, SIXTH PARAGRAPH

The Applicant maintains that claims 18 and 25 are both written in accordance with 35 U.S.C. §112, sixth paragraph. See e.g., Applicant's Response filed 6/11/04, pages 6-7; Applicant's Response filed 12/7/04, pages 10-11; Applicant's Response filed 10/19/05, page 11. It is not clear from the record whether the Examiner agrees with the Applicant that claims 18 and 25 invoke §112, sixth paragraph. In the Advisory Action mailed 10/27/05, the Examiner states:

Regarding Claim 18, the applicant has indicated that this claim is written in accordance with 35 U.S.C. §112, sixth paragraph. However, the claim states "first means supported by a top surface of the housing for facilitating said flow of atmospheric air through the climate conditioning aperture." (Advisory Action, page 2, lines 2-4, emphasis added)

The Applicant cannot reasonably determine from this language, and the rest of the record, whether the Examiner is treating the recited "first means" element as an element written in accordance with §112, sixth paragraph. This ambiguity on the part of the Examiner is clear error and results in an incomplete examination.

The law binding upon the USPTO is clear: if an applicant uses means type language followed by a recitation of functional language without a recitation of structure sufficient to carry out the functional language, the applicant is entitled to a presumption by the USPTO that the element is written in accordance with §112, sixth paragraph. See *In re Donaldson Co. Inc.*, 29 USPQ2d 1645 (Fed. Cir. 1994)(*en banc*); *Ethicon, Inc. v. United States Surgical Corp.*, 45 USPQ2d 1545, 1550 (Fed. Cir. 1998) ("use of the word means 'gives rise to a presumption that the inventor used the term advisedly to invoke the statutory mandates for means-plus-function clauses'"); MPEP 2181 et seq.; *Supplemental Guidelines for Determinining Applicability of 35 U.S.C. Para 6*, 65 FR 38510 (June 2000); *General Electric v. Nintendo*, 50 USPQ2d 1910 (Fed. Cir. 1998)(words appearing between the term "means" and "for" does not alter this presumption.)

2. THE EXAMINER HAS FAILED TO CORRECTLY CONSTRUE CLAIMS 18 AND 25 IN ACCORDANCE WITH §112, SIXTH PARAGRAPH

A means-element is construed as the corresponding structure disclosed in the specification that carries out the recited function, and equivalents thereof. *Donaldson, Supra*; MPEP 2181 et seq. Structure is “corresponding” for purposes of §112, paragraph 6, if one skilled in the art, upon a review of the specification and prosecution history, would readily associate that structure with the means-element. *B. Braun Medical v. Abbott Lab.*, 43 USPQ2d 1896 (Fed. Cir. 1997). In the present case, the Applicant has referred to the specification at page 11, lines 1-10, as disclosing the structure corresponding to the recited first means, including structure that is expressly excluded from coverage.

In the Advisory Action, the Examiner stated:

The Examiner maintains that the means for this function is Markey #152 [fan 152], the fan which is equivalent to applicant’s fan #134. The “first means” could also merely be the climate conditioning aperture. (p. 2, ll. 4-5, emphasis added)

It is impossible from this to determine the basis of the Examiner’s rejection. The fan 152 in Markey ‘371, by itself, fails to constitute the structure covered by the first means element of claims 18 and 25. Moreover, the “climate conditioning aperture” in Markey ‘371 CANNOT correspond to the recited first means element of claims 18 and 25 because the “climate conditioning aperture” was separately recited in these claims prior to the first means element, and the first means operates thereon. Thus, the foregoing reasoning is meaningless and results in an incomplete examination.

Regardless, when the first means element is properly construed, nothing in Markey ‘371 can be reasonably viewed as anticipating the recited first means element.

3. IF THE EXAMINER BELIEVES CLAIMS 18 AND 25 TO BE INDEFINITE, SHE IS OBLIGED TO REJECT THE CLAIMS UNDER 35 U.S.C. §112, SECOND PARAGRAPH

The Examiner appears to believe claims 18 and 25 to be indefinite, but has not rejected the claims on this basis, and instead has merely construed the means element as any prior art structure that carries out the recited function. This is erroneous as a matter of law. As stated by the Advisory Action:

The specification does not provide a clear definition of the structure intended to be associated with this function, i.e., the structure is not described in the specification in specific terms. Applicant has presented various embodiments of the device and has not explicitly defined the means plus function terms in the specification. Currently, the examiner maintains that in light of the broad claim language and the specification, the fan of Markey satisfies this limitation.
(Advisory Action, page 2, lines 5-9)

If a means-element is viewed as being indefinite, the Examiner is obliged to reject the claim under §112, second paragraph, to give the Applicant an opportunity to traverse this finding and/or to clarify the record as to what is covered. MPEP 2181; *Atmel Corp. v. Information Storage Devices, Inc.*, 53 USPQ2d 1225 (Fed. Cir. 1999); *B. Braun Medical, Supra*. The Examiner is not entitled to treat the “indefiniteness” in such a way as to avoid proper construction of the claim.

Claim Language at Issue for Obviousness Rejection

With regard to the obviousness rejection, independent claim 1 generally features “a climate conditioning unit configured for removeable attachment to the housing adjacent the climate conditioning aperture, the climate conditioning unit contactingly supported by a top surface of the housing at a position a selected distance away from the climate conditioning aperture so as to form a gap therebetween.”

Deficiencies of Obviousness Rejections

The Applicant respectfully notes the following deficiencies in the legal requirements for establishing an obviousness rejection of claims 1-9, 11-13, 15-17, 20 and 26-30:

I. THE EXAMINER HAS FAILED TO ACCOUNT FOR ALL CLAIM LIMITATIONS AS REQUIRED TO ESTABLISH A §103 REJECTION

The Examiner postulated that it would be an “obvious design choice” to make the chimney 64 of Markey ‘371 removeable, which the Applicant traverses, but even with this modification the combined teachings and suggestions of Markey ‘371 and Corbett ‘906 fail to account for all of the limitations of the claims. See *In re Fine*, 5 USPQ2d 1596 (Fed. Cir.

1988). The heater 10 of Corbett 906 is configured to fit within a recess in the ceiling 11 of a bathroom (Corbett '906, col. 3, lines 71-75; FIG. 1).

Thus, there is no teaching or suggestion at least for the "*contactingly supported by a top surface*" language of the claims; that is, combining Markey '371 with Corbett '906 in the manner suggested does not result in the claimed combination.

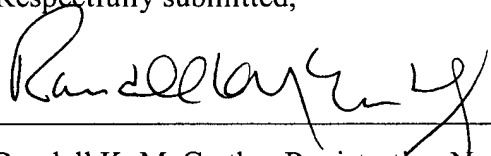
II. THE EXAMINER HAS ENGAGED IN IMPROPER HINDSIGHT RECONSTRUCTION TO FRAME THE REJECTION

The claimed invention results in a removeable climate conditioning unit that can readily be placed onto the top surface of the housing without the need as with prior art units to reach into or otherwise access the interior of the enclosure. Yet both Markey '371 and Corbett '906 teach assemblies that are INSERTED FROM BELOW the top of the housing. The Examiner has failed to provide any clear and particular evidence that one skilled in the art would be motivated to arrive at the claimed combination from the respective references. *In re Dembiczak*, 50 USPQ2d 1614 (Fed. Cir. 1999).

Accordingly, the Examiner has engaged in improper hindsight reconstruction, and the rejection is clearly erroneous and incomplete.

Respectfully submitted,

By: _____


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